

# REMARKS

## I. CLAIM OBJECTION

The wording in the last paragraph of claim 16 was objected to on the grounds that it might be interpreted as implying that both the stationary blade and the oscillating blade are driven by the drive unit.

The specification and drawing fully support the claimed arrangement in which the oscillating blade is arranged on the side of the stationary blade opposite from the handle side, i.e. in which the stationary blade is arranged between the handle and the oscillating blade. See figs. 6 and 5 and figs. 14 to 16, which illustrate embodiments with this feature. Also note the description in the paragraph between page 9, line 26, and page 10, line 9, of applicants' originally filed specification. In order for the pin 43 attached to the eccentric drive shaft 42 of drive unit 54 to pass through the opening 44 in the stationary blade 18 and engage in the catch 45 of the oscillating blade 20, the stationary blade 18 must be between the handle 12 (which contains the drive unit) and the oscillating blade 20.

The arrangement of the stationary blade between the oscillating blade and the handle is unique to the claimed invention and is a difference between the applicant's claimed apparatus and the apparatus disclosed in the prior art of record.

Also the opening 44 through which the connection between the drive unit

and the oscillating blade is made is introduced into claim 16. The disclosures in paragraph between page 9, line 26, and page 10, line 9, of applicant's originally filed specification support this change in claim 16.

## II. OBVIOUSNESS REJECTION

Amended claims 11 to 16 were rejected as obvious under 35 U.S.C. 103 (a) over Abraham, et al, WO 02/36314 A1 (referred to as "Abraham" herein below), in view of Hildebrandt, German Patent 33 107 06 A1 (referred to as "Hildebrandt" herein below).

Claims 11 to 16 are apparatus claims, not method claims. Independent claim 16 claims a haircutting machine in which the stationary blade is arranged between the oscillating blade and the handle or cutting head.

This structural arrangement of these parts of the claimed haircutting machine is the opposite from the arrangement according to Hildebrandt, in which the upper blade 16 reciprocates between the stationary blade 2 and the drive mechanism in the cutting head, i.e. between the stationary blade 2 and the cutting head 1 in the handle 24 (as shown in fig. 2 of Hildebrandt. The applicant's haircutting machine of claim 16 provides a better quality of haircutting than that of Hildebrandt because most of the outer flat surface of the oscillating blade 20 can be brought into physical contact with hairs that are about to be cut for reasons explained more fully herein below. In contrast, in the case of the cutting head 1 shown in fig. 1 of Hildebrandt, the one flat surface of the oscillating or upper

and the oscillating blade is made is introduced into claim 16. The disclosures in paragraph between page 9, line 26, and page 10, line 9, of applicant's originally filed specification support this change in claim 16.

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blade 16 bears on the stationary blade 2 and the flat surface on the opposite side of the blade 16 is inside the cutter head 1. Thus the opposite flat surfaces of upper blade 16 are both shielded from direct physical contact with hairs to be cut by the stationary blade 2 and the interior portion of the cutter head 1.

The arrangement of the stationary and oscillating blades according to applicant's claim 16 is also the opposite from the practical embodiment with the pivoting cutter head 50 shown in figs. 4 to 7 of Abraham, which has the oscillating blade 57 arranged between the stationary blade 55 and the body of the cutter head 50, which is mounted on the handle 20 (page 3, line 30, to page 4, line 5, of Abraham). In the embodiment of figs. 4 to 7 the cutter head 50 is pivotable between a set of preset positions 70-1 to 70-5 shown in figs. 4 to 7, as described on page 4, lines 21 and following of Abraham. For proper haircutting the cutter head 50 must be secured in a fixed position prior to cutting. Page 4 of Abraham describes an appropriate mechanism for doing that.

However in all embodiments disclosed in Abraham and especially the embodiments shown in figs. 4 to 7 of that reference the oscillating blade 57 is arranged between the stationary blade 55 and the remaining portion of the cutter head that contains the drive mechanism. Thus in Abraham like Hildebrandt the flat surface of the oscillating blade 57 is almost completely shielded from direct physical contact with the hairs to be cut either by the stationary blade 55. The advantages of the arrangement of claim 16 are described further herein below.

Also the specifications of both prior art references do not describe any embodiments of the haircutting machine in which the stationary blade is arranged

between the oscillating blade and the handle or cutting head as in claim 16.

Although rearrangement of the parts of an apparatus has been held to be obvious in the case of some patent applications (M.P.E.P.2144.04, VI), more recently it has been held that:

**"The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). [underlining ours]**

In other words, in order for a valid conclusion that the applicant's "design choice" is obvious under 35 USC 103 in view of the prior art of record, the prior art must provide a reason for making the rearrangement according to applicants' claim 16. However no such reason is provided in Abraham or Hildebrandt. Furthermore it is unlikely that one skilled in the art would consider that as a possible alternative after consulting Abraham and Hildebrandt because it requires at least some extra effort to produce the apparatus in which the oscillating blade is driven according to claim 16. In the case of claim 16 the drive mechanism must be connected to the oscillating blade through the stationary blade by means of a shaft extension or elliptical coupling instead of by direct engagement of a gear with the adjacent oscillating blade, for example as in the apparatus of fig. 2 of Hildebrandt.

Furthermore it is respectfully submitted that the arrangement of the oscillating blade between the stationary blade and the handle is not merely a

matter of obvious design choice, but does provide some advantages in relation to the opposite arrangement in the prior art.

Pages 2 and 3 of the applicant's specification teach certain special advantages of the apparatus as claimed in the above amended claim 16. The second full paragraph on page 2 is as follows:

*"With the handle of the hair cutting machine in the operating position, because the cutting plane is inclined downward in relation to the longitudinal axis of the handle, with the oscillating blade disposed above the stationary blade, the oscillating blade on the cutter head of the hair cutting machine is oriented so that the oscillating blade produces a vibrating action with approximately 25 to 50 oscillations per second in order to continuously guide strands of hair into the stationary blade, which produces a fine, dense thinning of hair. This vibrating action of the oscillating blade is an additional characteristic and an important component for achieving a cutting result with a hair cutting machine equal to that of a scissors cut."* (italicized emphasis ours)

Because the oscillating blade is arranged above the stationary blade, i.e. the stationary blade is between the oscillating blade and the handle, the reciprocating flat outer surface of the oscillating blade may be brought into a sideways contact with hairs to be cut as shown in figs. 12 and 12a of applicant's specification. As a result of the oscillating motion, the hairs are drawn into the stationary blade as explained in the above paragraph from the applicant's specification. In contrast in the apparatus according to the prior art references the oscillating blade is shielded from direct sideways contact with the hairs to be cut by the stationary blade.

Other advantages also result from the arrangement of the blades in the cutter head according to claim 16 (page 3, applicants' specification), such as the

fact that the cut is clearly visible while operating the haircutting machine and that simple contour cutting is possible without having to rotate or change the orientation of the haircutting machine by a manual operation such as turning it over.

It is impossible to adjust or orient the haircutting machine e.g. with the structure shown in figs. 4 to 8 of Abraham so that the oscillating blade 57 is between the stationary blade 55 and the remainder of the cutting head 50 (opposite from the arrangement of applicants' claim 16).

An "amendment figure" accompanies this amendment that shows a comparison of the mirror image of e.g. fig. 8 of Abraham (the mirror image makes the comparison easier to understand) with the applicant's embodiment of figure 6, which is oriented as shown in figure 10 with the reference numbers according to figure 10. The "amendment figure" is added simply to provide a better understanding of the applicant's invention as claimed in the more limited claim 16 and is not to be added to the figures that would be published with any issued patent. The oscillating blade 20 and stationary blade 18 are shown enlarged in the comparison figure attached to the amendment so that their relationship to the handle 10 is easily seen.

Thus there are significant differences between the apparatus claimed in the amended claim 16 and the apparatus represented by the combination of Abraham and Hildebrandt that are not a matter of mere design choice, which influence the nature and quality of the provided haircutting. The haircutting provided by the apparatus according to claim 16 is advantageously better than

that provided by the prior art because of the arrangement of the oscillating blade and stationary blade according to claim 16.

Furthermore if one supposes for the sake of argument that a prior art haircutting machine could be found that provides a similar quality haircut to that provided by the apparatus of claim 16, the apparatus as claimed in claim 16 makes it easier to obtain a scissor-type cut without complicated manipulations of the orientation of the haircutting machine and time-consuming adjustments of the hair cutting machine.

For the foregoing reasons and because of the changes in amended claim 16, withdrawal of the rejection of amended claims 11 to 16 under 35 U.S.C. 103 (a) over Abraham, et al, WO 02/36314 A1, in view of Hildebrandt (German Patent 33 107 06 A1), is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.



In view of the foregoing, favorable allowance is respectfully solicited.

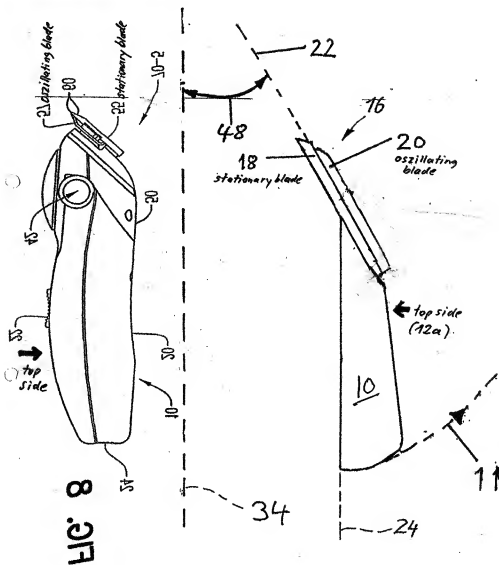
Respectfully submitted,

  
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# AMENDMENT FIGURE



"FIG. 10"